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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/691,645

10/18/2000

Rudolf Maurer

15258-049600US

4394

7590

12/09/2003

EXAMINER

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ART UNIT

PAPER NUMBER

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/691,645

Applicant(s)

MAURER ET AL.

Examiner

David L. Sorkin

Art Unit

1723

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 25 September 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☒ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

see attached detailed explanation

NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR

1.192(c)

1. 37 CFR 1.92(c)(3) requires a "statement of the status of all claims, pending or cancelled, and identifying the claims appealed". Appellant's statement fails to address claims 1-10. The examiner considers that claims 1-8 and canceled, claims 9 and 10 are withdrawn from consideration as directed to non-elected inventions, and claims 11-19 are finally rejected. Appellant may agree or disagree with the examiner, but must take a position regarding the status of each claim. Also, while one might assume that claims 11-19 are being appealed, it is suggested that appellant explicitly state what claims are being appealed.

2. 37 CFR 1.192(c)(5) requires that the summary of the invention "shall refer to the specification by page and line number". The summary of the invention contained in the brief completely fails to refer to the specification by page and line number. Furthermore, specification is quoted without stating where the quotations are found. See MPEP 1206 for a further explanation of this requirement, where it is stated that "[w]hile reference to page and line number of the specification may require somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application".

3. The brief contains numerous inaccurate statements concerning 35 USC 132(a). No claim has been rejected or objected to as containing "new matter" under section 132 or any other section. No determination that any proposed claim contains or does not

contain "new matter" has been made. The proposed amendment filed 09 May 2003 was refused entry and hence has not been fully considered with regard to patentability. While one of the reasons for not entering the proposed amendment was that it raises the issue of new matter, raising the issue of new matter is not the same as actually containing new matter. In other words, the proposed claims have not been fully examined and, if fully examined, may or may not be determined to contain "new matter". If determined to contain "new matter", a rejection under the description requirement of section 112, first paragraph (rather than section 132) would be appropriate. The proposed amendment of 09 May 2003 was refused entry under 37 CFR 1.116, (not 35 USC 132(a)). As explained in MPEP 714.12, under the heading "ENTRY NOT A MATTER OF RIGHT", "[i]t should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims".

4. In the "STATUS OF CLAIMS" section, the brief states "Pursuant to the practice set forth in MPEP Section 608.04(c)..."; however, this MPEP section refers to situations in which an actual rejection or objection occurred. If a claim were actually rejected as containing new matter, such a rejection would be a properly appealable issue. However, the non-entry of an after-final amendment is not a properly appealable issue.

Appellant is required to comply with provisions of 37 CFR 1.192(c).

To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 1.192(c) within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication;

Application/Control Number: 09/691,645
Art Unit: 1723

Page 4

- (2) within the time period for reply to the action from which appeal has been taken; or
- (3) within two months from the date of the notice of appeal under 37 CFR 1.191.


Extensions of these time periods may be granted under 37 CFR 1.136.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


David Sorkin


CHARLES E. COOLEY
PRIMACY EXAMINER